

REMARKS/ARGUMENT

I. General Remarks.

Please consider the application in view of the following remarks. Applicants thank the Examiner for his careful consideration of this application.

II. Disposition of Claims

Claims 1-28, 30-39 and 123-191 are pending in the application.

Claims 1-28, 30-39, and 123-191 are rejected.

Applicants respectfully request reconsideration in light of the arguments and remarks contained herein.

III. Remarks Regarding Obviousness-Type Double Patenting.

The Examiner had previously rejected claims 1-39 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6,796,378 B2 (hereinafter "*Reddy*"). In response to the prior office action, Applicants respectfully submitted that the Petition to withdraw the Terminal Disclaimer was dismissed, and therefore, the Terminal Disclaimer is still in effect prompting the withdrawal of the double patenting rejection.. In the Office Action dated July 13, 2007, the Examiner stated:

The applicants petition to withdraw the terminal disclaimer was dismissed. Therefore, the terminal disclaimer is still active and the ODP rejection has been again withdrawn because of this dismissal.

(Office Action at 2.) Applicants thank the Examiner for his careful consideration of these remarks and the withdrawal of the obviousness-type double patenting rejection.

IV. Remarks Regarding Objection to the Specification.

The Examiner had previously objected to the specification under 35 U.S.C. § 112, 1st Paragraph as failing to define the term "activate" (*i.e.* the cement composition) or an "activator." In the Office Action dated July 13, 2007, the Examiner stated:

The objection to the specification has been withdrawn. The applicants state that an activator is *substantially similar* to what are referred to as accelerators (p. 14 of 20 of 5/7/07 response). The definition provided by applicants is vague. The examiner does not understand exactly what is meant by these terms. Nevertheless, he has interpreted "activator" and "accelerator" to be *synonymous terms* for the purpose of the examination of this instant application. The applicants have also stated that accelerator is generally used to refer to a particular cement composition not comprising a retarder.

However, there are many patents that do use accelerator and retarder in the same composition and do not use the term "activator". Nevertheless, applicants are permitted to an extent to be their own lexicographer and the examiner thus has interpreted activator and accelerator to have the same meaning.

(Office Action 2.) Applicants thank the Examiner for his careful consideration of these remarks and the withdrawal of the objection to the specification under 35 U.S.C. § 112, 1st Paragraph.

V. Remarks Regarding Rejections of Claims 1-28, 30-39 and 123-191 Under 35 U.S.C. §§ 102/103.

The Examiner has rejected claims 1-28, 30-39 and 123-191 under 35 U.S.C. § 102(a) and (b) as anticipated by, or in the alternative, under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 4,393,939 to Smith et al. ("*Smith*"), U.S. Patent No. 3,508,407 to Booth ("*Booth*") alone or in view of U.S. Patent No. 5,588,488 to Vijn et al. ("*Vijn*"), U.S. Patent No. 6,087,418 to Yamashita, U.S. Patent No. 6,089,318 to Laramay et al. ("*Laramay*"), Scheetz et al. (abstract) ("*Scheetz*"), or U.S. Patent No. 4,131,480 to McCurrich ("*McCurrich*").

With respect to these rejections, the Office Action states:

The primary references above reach adding a cationic polymer to cement. The prior art cationic polymer is the same as applicants' cationic polymer and thus would also function as their particle size distribution adjusting agent. The applicants particle size distribution adjusting agent is essentially new words for defining what is already old in the art. Namely, this PSDA agent is actually a flocculent or flocculating agent which causes particles in suspension to floc together or agglomerate (see page 7, line 8 of applicants' specification). The activator or activating agent reads upon either water (which activates the hydraulic activity of cement) or an accelerator which accelerates and activates the rapid setting of cement. Note that in claim 1 applicants do not specify or define any specific activators and though they may mean accelerator by the use of the term activator, water is the only ingredient which imparts the hydraulic activity to cement and starts the hydraulic reaction for hardening and setting of the cement.

The use of a retarder is *conventional* and well known in cement compositions to retard or delay the setting of cement. Vijn et al. '488 teaches in column 4, lines 24-35 that the addition of a retarder to cements for applicants such as well cements is known and conventional in the art. Vijn also teach adding dispersing agents, defoamers, silica flour, formation conditioning additives, expansion aids, set accelerators (activators), weighting agents,

lightening agents such as fly ash or fumed silica (see col. 4 lines 10-16 and col. 5, lines 1-20).

Yamashita et al. '418 teach *conventional* additives to cement compositions include retarders such as phosphonic acids and their derivatives (col. 17, line 25), high early strength agents (ie accelerators or as applicants name them activators) such as KOH or NaOH (col. 17, lines 35-40) as well as alkanolamines, surfactants (same as surface active agents-see col. 18, lines 35-55), thickeners (same as viscosifiers-see col. 19, line 3), silica fume, fly ash, etc. Yamashita et al. further teach these additives may be added in plural (col. 19, line 9).

Laramay et al. '318 teach adding *conventional* additives to cement compositions such as fluid loss additives, viscosifiers, retarders, accelerators (ie activators), dispersants, weight adjusting agents, fillers, (see col. 10, lines 25-30), surfactants (col. 11, line 14), fly ash, silica flour, etc. (col. 11, lines 20-23). It would have been an obvious design choice for one of ordinary skill in the art to add conventional cement additives of Laramay et al. '318, Vijn et al. '488, and Yamashita et al. [sic] '418 to cement compositions such as those of the primary references because these are routinely used in the art.

Scheetz and McCurich '480 et al. teach the addition of sulfonated naphthalene condensate is old in the cement art as an additive because it is a conventionally used superplasticizer (dispersant) for improving the pumpability of the cement slurry (see abstract). The applicants call this component a "yield stress reducing agent" but it is better known in the art as a superplasticizer (or dispersant) which are conventional additives to improve cement pumpability.

(Office Action at 3-4.) Applicants respectfully disagree.

A. Rejection of Claims Under U.S.C. § 102(a) and (b)

To form a basis for a 35 U.S.C. § 102(a) rejection, a prior art reference must disclose each and every element as set forth in the claim. *See* MANUAL OF PATENT EXAMINING PROCEDURE § 2131 (2005). "The identical invention must be shown in as complete detail as it is contained in the claim." Similarly, in order to form a basis for a rejection under 35 U.S.C. § 102(b), a prior art rejection must disclose each and every element as set forth in the claim. *Smith* nor *Booth* disclose each and every element as set forth in independent claims 1, 123, and 159 in present form.

With regard to *Smith*, it teaches away from the discussed “polyacrylamides” that comprise the cationic polymer. *See* Application, ¶ [0027] Instead, *Smith* discloses that the cationic organic polymer will normally be incompatible with additives ... such as in substantially hydrolyzed polyacrylamides or polyacrylic acid used to reduce the fluid loss from the slurry...often used to retard the setting of cement.” *See* col. 4, lines 17-27. Further, *Smith* fails to disclose or suggest a method of cementing comprising “permitting the cement composition to remain in slurry state for a period of time prior to the cement composition being activated.” In addition, Applicants respectfully assert that the Examiner’s characterization of “water” as reading upon the activator or activating agent does not provide an accurate view of the claims in lieu of the specification. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312-19 (Fed. Cir. 2005) (*en banc*). Applicant’s Specification, for example, provides a variety of representative activator compositions. *See* Application, ¶ [0033].

With regard to *Booth*, *Booth* fails to disclose each and every limitation as set forth in claim 1 in its present form because *Booth* does not disclose a method of cementing comprising “permitting the cement composition to remain in slurry state for a period of time prior to the cement composition being activated” as required by claims 1, 123 and 159. Further, Applicant’s Specification provides that it may be desirable to prepare a volume of a cement composition that is capable of remaining in a slurry state for a desired period of time. *See* Application, ¶ [0003] - [0006]. More specifically, Applicants provide that the “settable fluids of the present invention are capable of remaining stable in a slurry state for several weeks or more before being activated by the addition of an activator composition.” *See* Application, ¶ [0027].

Consequently, for at least the above stated reasons, Applicants respectfully submit that claims 1, 123 and 159 are all patentable over either *Smith* or *Booth*. Moreover, since “a claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers,” and since claims 2-28, 30-39, 124-158, and 160-191 depend, either directly or indirectly, from claim 1, these dependent claims are allowable for at least the same reasons. *See* 35 U.S.C. § 112 ¶ 4 (2005). Accordingly, Applicants respectfully request the withdrawal of these rejections.

B. Rejection of Claims Under U.S.C. § 103(a)

Applicants respectfully disagree with these rejections because the Examiner has not established a *prima facie* case of obviousness, in that the cited references do not disclose,

expressly or inherently, each and every claim limitation and there is no teaching or suggestion to combine the references. MPEP § 2143.03 (2005). In order for a combination of references to form the basis for a rejection under § 103(a) the combination of references must teach or suggest all the elements of the claim. *Id.*

As to claims 1, 123 and 159, none of the cited references discloses, expressly or inherently, each and every limitation. Further, there is no teaching or suggestion to combine the reference. With respect to *Vijn*, upon which the Examiner relies heavily, *Vijn* fails to disclose a method of cementing comprising “permitting the cement composition to remain in slurry state for a period of time *prior* to the cement composition being *activated*.” (emphasis added) Rather, *Vijn* discusses the use of set retarders “to extend the time in which the cement slurry composition can be pumped.” The *Vijn* reference discusses the ability to retard activated cement compositions for the purpose of preventing “shocks and impacts from subsequent drilling and completion operations carried out in the well” from shattering the cement. *See* col. 4, lines 24-35 and col. 5, lines 38-59. The use of a set retarder in an activated cement does not disclose “permitting the cement composition to remain in slurry state for a period of time *prior* to the cement composition being *activated*.” (emphasis added) Nor can *Yamashita*, *Laramay*, *Scheetz*, or *McCurich* be used to provide the necessary recitation.

Accordingly, for at least the reasons stated above in Section V.A., *Smith* or *Booth*, alone or in view of *Yamashita*, *Laramay*, *Scheetz*, or *McCurich* do not obviate independent claims 1, 123 and 159. Moreover, since a claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers,” and since claims 2-28, 30-39, 124-158, and 160-191 depend, either directly or indirectly, from claim 1, these dependent claims are allowable for at least the same reasons. *See* 35 U.S.C. § 112 ¶ 4 (2005). Accordingly, Applicants respectfully request the withdrawal of these rejections.

VI. No Waiver.

All of Applicants’ arguments and amendments are without prejudice or disclaimer. Additionally, Applicants have merely discussed example distinctions from the Cited References. Other distinctions may exist, and Applicants reserve the right to discuss these additional distinctions in a later Response or on Appeal, if appropriate. By not responding to additional statements made by the Examiner, Applicants do not acquiesce to the Examiner’s additional statements, such as, for example, any statements relating to what would be obvious to

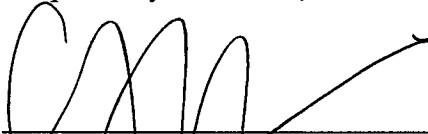
a person of ordinary skill in the art. The example distinctions discussed by Applicants are sufficient to overcome the anticipation and obviousness rejections.

SUMMARY

In light of the above remarks, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections. Applicants further submit that the application is now in condition for allowance, and earnestly solicit timely notice of the same. Because this response has been filed within two months of when the Final Office Action was issued, Applicants respectfully request that the Examiner issue an advisory action if the Examiner does not find the claims to be allowable in light of the amendments and remarks made herein. Should the Examiner have any questions, comments or suggestions in furtherance of the prosecution of this application, the Examiner is invited to contact the attorney of record by telephone, facsimile, or electronic mail.

Applicants believe that there are no fees due in association with the filing of this Response. However, should the Commissioner deem that any fees are due, including any fees for any extensions of time, Applicants respectfully request that the Commissioner accept this as a Petition therefore, and directs that any fees be debited from Baker Botts L.L.P., Deposit Account No. 02-0383, Order Number 063718.0359.

Respectfully submitted,



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